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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,027	01/22/2002	Raymond Wells	AMSP51552	8685

466 7590 04/29/2003

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745 SOUTH 23RD STREET 2ND FLOOR  
ARLINGTON, VA 22202

EXAMINER

KAVANAUGH, JOHN T

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 04/29/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/000,027

Applicant(s)

WELLS, RAYMOND

Examiner

Ted Kavanaugh

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Claim Rejections - 35 USC § 112***

1. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "means for guiding the heel of a user's foot as the user inserts the foot into the shoe" is indefinite because the element(s) or step(s) is/are not defined in the specification by corresponding structure, material or acts and equivalents thereof, see 35 USC 112, sixth paragraph, and therefore it is not clear what is meant by that language. Therefore, the examiner is unable to determine what structure or equivalent structure is encompassed by such language. It is clear from applicant's remarks that he is invoking 35 USC 112, 6<sup>th</sup> paragraph and applicant refers to the specification for a determination of equivalent thereof. However, the examiner is unable to determine such structure from the specification. The PTO must apply 35 U.S.C. 112, sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application. See *Donaldson*, 16 F.3d at 1194, 29 USPQ2d at 1850. In the event that it is unclear whether the claim limitation falls within the scope of 35 U.S.C. 112, sixth paragraph, a rejection under 35 U.S.C. 112, second paragraph may be appropriate. Since there is no corresponding structure, etc. in the specification to define the means or step plus function limitation, an equivalent will be deemed to be any element that is capable of performing the specified function.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 4608769 (Sturlaugson).

Sturlaugson teaches a shoe horn attachment (6) for a shoe substantially as claimed including equivalent means for guiding the heel of the user's foot (the back portion of the shoehorn including the upper portion 26) as the user inserts the foot into the shoe and at least one fastener (stitching; see col. 4, lines 7-9) for securing the attachment to the shoe.

4. Claims 1-4, 7-10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by UK 2235360 (Sessa).

Sessa teaches a shoe horn attachment (see figure 5) for a shoe substantially as claimed including equivalent means for guiding the heel of the user's foot (the back portion of the shoe horn including the upper portion 52 form a ramp for guiding the heel into the shoe; see page 5, lines 6-13) as the user inserts the foot into the shoe and at

Art Unit: 3728

least one fastener (VELCRO 60) for detachably securing the attachment device to the shoe and another fastener (adhesive; see page 5, lines 24-27) for securing the attachment to the shoe. See figures 1 and 2 which show the multiple positions the upper back part can be in and therefore extends "obliquely from the back portion outside of a rim of a shoe"; claim 7. Regarding claim 9, see figure 1, which shows the upper back portion retaining the shoe horn on the shoe wherein the upper back portion has an essentially an inverted V-shape. Regarding claim 10, the reinforcing binding 54 (see figure 2) extends laterally from the retaining member and therefore serves as a wing member as claimed. Regarding claim 13, the upper back portion further has a rearward-projecting portion (the portion that the VELCRO extends from) extending from said upper back portion. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4503628 (Mancinelli).

Mancinelli teaches a shoe insert (10) for a shoe substantially as claimed including equivalent means for guiding the heel of the user's foot (the back portion of the shoe insert has a contour of the back portion of the shoe and hence has a contour of a back portion of a user's heel; Moreover, see lines 16-26 of the abstract) as the user inserts the foot into the shoe, and having a being crimped over the back rim of the shoe (best shown in figure 2) and at least one fastener (self-adhesive strips 30,32) for securing the attachment to the shoe. The shoe insert (10) is a shoe horn inasmuch as it functions as an aid to facilitate slipping the heel of the foot into the shoe, see the abstract.

Art Unit: 3728

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-9,11-12,14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 1012253 (Gerhart) in view of US 5901468 (Whyte).

Gerhart teaches a heel lining and protector (the device is inherently a shoe horn) that is for ready attachment within a shoe (see page 1, col. 1, lines 9-16) comprising equivalent means for guiding the heel of the user's foot (the back portion of the device including the cuff like portion (8) has equivalent structure as claimed) as the user inserts the foot into the shoe and at least one fastener (VELCRO 60) for detachably securing the attachment device to the shoe and another fastener (cement; see page 1, lines 79-81) for securing the attachment to the shoe substantially as claimed except for the fastener (the cement) a readily removable fastener. See figures 2 and 4 which show the position the upper back part can be in and therefore extends "obliquely from the back portion outside of a rim of a shoe"; claim 7. Regarding claim 9, see figures 2 and 4, which shows the upper back portion retaining the device on the shoe wherein the upper back portion has an essentially an inverted V-shape. Whyte teaches an insert device which is attached inside the shoe on the bottom portion thereof with a double-sided adhesive tape to facilitate removing the insert. It would have been obvious to

provide the device of Gerhart with the fastener being a double-sided adhesive tape on the bottom thereof, as taught by Whyte, to facilitate removing the device when worn-out.

***Response to Arguments***

8. Applicant's arguments filed April 15, 2003 have been fully considered but they are not persuasive.

Applicant argues that Sturlaugson doesn't teach the means for guiding as claimed or any equivalent thereof. Applicant is invoking 35 USC 112, 6<sup>th</sup> paragraph by such language. Applicant argues "STURLAUGSON teaches an integral shoe horn which is specifically excluded as an equivalent element because as integral shoe horn is not an attachment but is part of a special shoe.

In response, the examiner does not understand applicant's argument. Applicant is using means plus function language with regard to the "means for guiding the heel...into the shoe". However, applicant basis for the argument is with regard to the shoe horn of Sturlaugson being integral and not an attachment. One has nothing to do with the other. Moreover, the shoe horn 6 of Sturlaugson has a contour that corresponds to the back of the heel and has an upper part that will facilitate sliding the heel of the foot into the shoe. Regarding the shoe horn being an attachment for a shoe, figure 3 shows the shoe horn and figure 1,2 and 4 show the shoe horn attached to the shoe.

Applicant argues that Sessa doesn't teach the means for guiding as claimed or any equivalent thereof. Applicant is invoking 35 USC 112, 6<sup>th</sup> paragraph by such language. Applicant argues teaches an integral shoe horn which is specifically

Art Unit: 3728

excluded as an equivalent element because as integral shoe horn is not an attachment but is part of a special shoe.

In response, the examiner does not understand applicant's argument. Applicant is using means plus function language with regard to the "means for guiding the heel...into the shoe". However, applicant basis for the argument is with regard to the shoe horn of Sessa being integral and not an attachment. One has nothing to do with the other. Moreover, the shoe horn of Sessa has a contour that corresponds to the back of the heel and has an upper part that will facilitate sliding the heel of the foot into the shoe. Regarding the shoe horn being an attachment for a shoe, figure 5 shows the shoe horn and figure 1,2 and 3 show the shoehorn attached to the shoe.

Applicant argues the shoe insert of Mancinelli doesn't teach means for guiding as claimed.

To the contrary, as best understood, the back of the shoe insert has a contour that corresponds to the back of the heel and since the insert facilitates sliding the heel of the foot into the shoe it appears to have equivalent structure as claimed.

### ***Conclusion***

**Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111. Moreover, "The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06" MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.**

**9. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



***A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.***

10. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9302 and After Finals to (703) 872-9303 (**FORMAL FAXES ONLY**). If the previous Fax numbers are not working use any of the following numbers (703) 305-3579 or (703) 305-3580 or (703) 305-3590. Applicants who authorize charges to a PTO deposit account may also use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov .

Art Unit: 3728

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached on 6AM - 4PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached at (703) 308-2672.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
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If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>

  
Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK  
April 24, 2003